

REMARKS

Claims 1 and 4 are amended. New claims 22-25 are added. Such new claims are readable on the species of Fig. 2 which Applicant elected in the response filed October 22, 2002. Claims 1-4 and 22-25 are pending in the application. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Claims 1-4 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4 stand rejected under 35 U.S.C. §102(b) as being anticipated by Holderer et al. **Please note:** the Examiner referred to '189 which is the untranslated EPO version of a family of applications which include U.S. pat. no. 6,503,383 (see priority information of both to DE 197 35 831, priority date of 8/18/97). Hereinafter, all reference to teachings of Holderer are from U.S. pat. no. 6,503,383.

Regarding the rejection against claim 1-4 under 35 U.S.C. §112, second paragraph, the Examiner states that the claims are indefinite for failing to set forth a method and lacking antecedent basis. Claims 1 and 4 are amended to clearly recite to a method and to provide antecedent basis. Accordingly, the §112, second paragraph rejection against claims 1-4 is rendered moot, and Applicant respectfully requests withdrawal of such rejection in the next office action.

Regarding the objection to the disclosure for referencing the language of claims 1 and 12, the specification is amended to delete the reference to the claims and to include the specific language of the respective claims. Accordingly, no new matter is added as the amendment language is the language of original claims 1 and 12, respectively, as provided in the in the originally-filed application. Consequently, this objection to the disclosure is rendered moot, and Applicant respectfully requests withdrawal of this objection in the next office action.

Regarding the anticipation rejection against claim 1 based on Holderer, such claim is amended to recite positioning a plurality of individual optical elements on a basic body. The amendment language is supported by an exemplary embodiment of the invention disclosed at Fig. 2 of the originally-filed application. Referring to anticipation rejections under 35 U.S.C. §102, the PTO and Federal Circuit provide that §102 anticipation requires that *each and every element* of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); MPEP §2131 (8th ed.). The corollary of this rule is that the absence from a cited §102 reference of *any* claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Holderer teaches a specific design for a mounting structure (Fig. 1) to support a single lens 7, and the only reasonable interpretation of Holderer is the mounting structure could only support a single lens. In no fair or reasonable interpretation

does Holderer teach or suggest positioning a **plurality of individual optical elements on a basic body** as recited in claim 1. Pursuant to the above authority, since Holderer fails to teach or suggest a positively recited limitation of claim 1, such claim is allowable.

Furthermore, Holderer fails to teach or suggest the positively recited limitation of connecting the plurality of the individual optical elements to the basic body by a galvanoplastic joining technique, as the teaching of Holderer is not enabling for this limitation. The Examiner is respectfully reminded that the Federal Circuit has stated that a reference contains an enabling disclosure for a rejection "if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) *citing* MPEP §2121.01 (8th ed.). The teachings of Holderer relied on by the Examiner to allegedly teach the above recited limitation (pg. 3 of paper no. 12) is stated as, "[i]f it is desired to eliminate adhesive [to secure lens to mounting structure], the mounting can be directly combined electrochemically with the optical element", (col. 3, lines 30-40 of '383) and then states the mold core for the spring hinge and outer ring can no longer be released by thermal shrinking. However, Holderer fails to enable how the lens would be combined with the mounting during the electrochemical process because during this process, as shown in Fig. 2, the core mold 4 necessarily **occupies the same space** where the lens is to be secured to the mounting structure, as is shown

in Fig. 3. No reasonable argument can be made to suggest that one skilled in the art is enabled from the teachings of Holderer to resolve this issue, and therefore, Holderer is not enabling for the positively recited limitation of claim 1. Pursuant to the above authority, the anticipation rejection is inappropriate for lack of an enabling reference, and therefore, the rejection against claim 1 should be withdrawn. For this additional reason, claim 1 is allowable.

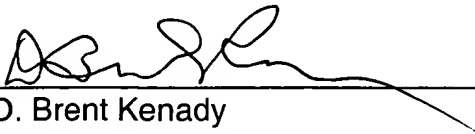
Moreover, a modification of the Holderer disclosure to allegedly teach the invention of claim under an obviousness rejection would be inappropriate. U.S. pat. no. 6,503,383 (including the family of applications) and the above-referenced application are commonly owned, and pursuant to 35 U.S.C. §103, such commonly owned reference is disqualified as prior art. *see also* MPEP §706.02(I)(3). For all these reasons, claim 1 is allowable.

Claims 2-4 and 22-25 depend from independent claim 1, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 7-23-03

By: 
D. Brent Kenady
Reg. No. 40,045